



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/876,322	06/16/97	ROBSON	D 7: ROBSON-CON

IM22/0914
THOMAS Q HENRY
WOODARD EMHARDT NAUGHTON MORIARTY
& MCNETT
111 MONUMENT CIRCLE SUITE 3700
INDIANAPOLIS IN 46204

EXAMINER

CINTINS, I

ART UNIT

PAPER NUMBER

1724

DATE MAILED:

09/14/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/876,322

Applicant(s)

Robson et al.

Examiner

Ivars C. Cintins

Group Art Unit

1724



☒ Responsive to communication(s) filed on Jul 6, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 3-6, 8-17, 20-22, 24, and 25 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 3-6, 8-17, 20-22, 24, and 25 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The disclosure is objected to because of the following informalities:

(1) this application fails to contain a brief description of the drawings, as required by 37 CFR § 1.74; and

(2) the reference to Applicant's prior applications, inserted before the first sentence of the specification via the amendment filed June 16, 1997, fails to contain a reference to PCT application No. PCT/GB91/01711, as required by 37 C.F.R. § 1.78(a)(2). Also, the relationship (i.e. "371") between this PCT application and Applicant's earliest U.S. patent application must be indicated. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The term "said method is for retaining transformer oil on paper" (claim 17, line 2) is vague, and indefinite as to the manipulative steps of the recited method.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by European patent application EP 0 213 252 A1. By Applicant's own admission (page 2, last paragraph of the response filed July 6, 1999), this reference discloses treating lignocellulosic material in the recited manner. Also, this reference teaches (see col. 4, line 12) that a "board" of lignocellulosic material may be treated by the disclosed process; and this "board" is deemed to be structurally and patentably indistinguishable from the broadly recited "sheet" of claim 22.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6, 8-16, 20-22, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sohnius (U.S. Patent No.

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3,607,741) in view of European patent application EP 0 213 252 A1. Sohnius discloses removing oil from water with a cellulosic material. Accordingly, this primary reference discloses the claimed invention with the exception of the specific cellulosic material employed. European patent application EP 0 213 252 A1 discloses treating a lignocellulosic material in the recited manner, and further teaches (see col. 1, lines 6-8) that such treatment increases the dimensional stability of the lignocellulosic material, and also improves its resistance to biological degradation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the treated lignocellulosic material of the secondary reference for the cellulosic material of the primary reference, in order to obtain the advantages disclosed by this secondary reference for the product of the primary reference.

Claims 1, 3-6, 11, 15, 17, 20, 22, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al (U.S. Patent No. 4,379,746) in view of European patent application EP 0 213 252 A1. Norman et al discloses filtering a transformer oil (col. 2, line 35) through paper (col. 2, line 67). Accordingly, this primary reference discloses the claimed invention with the exception of the recited esterification treatment for the paper. European patent application EP 0 213

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252 A1 discloses treating a lignocellulosic material in the recited manner; and it would have been obvious to one of ordinary skill in the art at the time the invention was made to treat the paper of the primary reference in the manner taught by the secondary reference, in order to obtain the advantages associated with such treatment for the paper of this primary reference.

Applicant's arguments filed July 6, 1999 have been noted and carefully considered, but no longer appear to be relevant in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (703) 308-3840. The examiner can normally be reached on Monday through Thursday from 7:30 AM to 6:00 PM.

The fax phone numbers for this art unit are: (703) 305-3599 for "Official" faxes after Final Rejection; (703) 305-7718 for all other "Official" faxes; and (703) 305-3602 for "Draft" and other "Unofficial" faxes.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.


Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
September 12, 1999